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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MUMTAZ SHAH

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Appeal 2010-002507  
Application 09/403,796  
Technology Center 3700

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Before: PHILLIP J. KAUFFMAN, CHARLES N. GREENHUT, and  
JAMES P. CALVE, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 20-24. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## THE INVENTION

Independent claim 20, reproduced below, is the sole independent claim on appeal.

20. Apparatus for cutting sheet material, comprising:

    a unit freely movable in both linear and non-linear paths having a lower part defining a sheet support surface for placing a piece of sheet material;

    an upper part defining an upper surface and disposed above said lower part with a gap existing between said upper part and said lower part for receiving the piece of sheet material;

    a cutting blade secured in said upper and lower parts, and extending across said gap, said sheet support surface and said upper surface extending to either side of said cutting blade; and,

    pressure means mounted on said upper part in said gap for bearing on the piece of sheet material supported by said lower part adjacent to said cutting blade, so that the piece of sheet material is able to be inserted between said pressure means and said sheet support surface for tensioning the piece of sheet material in proximity of said cutting blade.

## REJECTIONS

Appellant seeks review of the following rejections:

1. Claims 20-22 under 35 U.S.C. § 103(a) as unpatentable over Marcoux (US 3,835,536; iss. Sept. 17, 1974) and Campbell (US 3,068,569; iss. Dec. 18, 1962).
2. Claim 23 under 35 U.S.C. § 103(a) as unpatentable over Marcoux, Campbell, and Shah (GB 2 223 976 A, iss. Oct. 19, 1988).
3. Claim 24 under 35 U.S.C. § 103(a) as unpatentable over Marcoux, Campbell, and Li (US 5,638,603; iss. Jun. 17, 1997).

### CONTENTIONS AND ISSUES

This appeal presents the following issues:

Is Marcoux's apparatus freely movable in both a linear and a non-linear path as called for in claim 20?

Is Campbell non-analogous art?

### ANALYSIS

Appellant argues claims 20-22 as a group, and we select independent claim 20 as representative. App. Br. 6-12; *see* 37 C.F.R. § 41.37(c)(1)(vii). The rejections of claims 23 and 24 each rely, in part, on the same combination of Marcoux and Campbell relied upon for the rejection of claim 20, and Appellant argues the patentability of claims 23 and 24 solely based on their dependency from independent claim 20. Consequently, our analysis of claim 20 is applicable to claims 23 and 24.

We agree with Appellant that claim 20 calls for an apparatus having a structure capable of freely moving in both a linear and a non-linear path. App. Br. 7.<sup>1</sup>

The Examiner found that Marcoux discloses the structure of claim 20 (except a pressure means as disclosed by Campbell), and found that Marcoux's structure is capable of movement in both a linear and a non-linear path. Ans. 3-6. Though the Examiner's explanation of the interpretation of claim 20 differs from Appellant's interpretation (*see* Ans. 4-6), these findings demonstrate that the Examiner applied the same claim construction asserted by Appellant, namely, that claim 20 calls for an

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<sup>1</sup> Appellant incorporates by reference the claim construction asserted in the Amended Appeal Brief dated February 19, 2003, pp. 10-15.

apparatus having a structure capable of freely moving in both a linear and a non-linear path.<sup>2</sup>

The Examiner's finding that Marcoux's structure is capable of freely moving in both a linear and non-linear path if so manipulated by the user, is reasonable given that Marcoux's device includes a lower part (plastic bottom portion 27) having a smooth planar external bottom face 29 for sliding along a support surface. *See* Ans. 3, 5-6; Marcoux, col. 3, ll. 47-48, 53-54; col. 4, ll. 1-6; figs. 9, 10. This finding shifted the burden to Appellant to show that such is not the case. *See e.g., In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997); *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

Appellant attempts to carry this burden by arguing that because Marcoux's opposite sides 23 and 24 form a straight edge adapted to run along a ruler in either of two longitudinal directions, "non-linear cuts are not intended and would not appear to be possible." App. Br. 8-9. Appellant also contends that Marcoux's cutter is unable to cut sheet material in a curved or non-linear path because the entire periphery of bottom portion 27 (end sharp edge 30 and lateral sharp edges 31') forms a sharp edge. App. Br. 9-10; Reply Br. 4-5.

We agree with Appellant that Marcoux discloses a cutting device that includes a pair of substantially parallel opposite sides 23 and 24 that form a straight edge adapted to run along a ruler 20. *See* Marcoux, col. 1, l. 3; col. 3, ll. 36-42; figs. 8-11. However, the fact that Marcoux's device may be used in conjunction with a ruler does not demonstrate that the device is incapable of freely moving along a non-linear path. To the contrary, Marcoux's disclosure of use of the cutting device in conjunction with a ruler

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<sup>2</sup> Even though the Examiner referred to the freely movable limitation as "de minimis" (Ans. 5), the Examiner gave the limitation appropriate weight.

suggests Marcoux's device would move in a non-linear path without the guidance of the ruler.

We also agree with Appellant that the entire periphery of bottom block-like portion 27 forms a continuous sharp edge (end sharp edges 31 and lateral sharp edges 31'). *See* App. Br. 9-10; Reply Br. 4-5; Marcoux, col. 3, ll. 60-66; figs. 8-11. This periphery forms an entrance ramp for the sheet material. *Id.* Despite the continuous sharp edge of the bottom block-like portion 27, Marcoux's device is able to move in either longitudinal direction. Marcoux, col. 4, ll. 1-6. We fail to see, and Appellant does not cogently explain, how having a continuous sharp edge along the periphery of the bottom portion 27 permits free movement along a linear path, yet prohibits free movement along a non-linear path.

Appellant also argues that runner 15 of the claimed device permits non-linear cuts and the absence of such a structure in Marcoux demonstrates the Marcoux is incapable of non-linear movement. Reply Br. 5-6. Appellant's Specification describes that the underside of the lower part may be provided with runners, slides, or rotatable members. Spec. 3:4-6. However, claim 20 calls for the lower part to define a sheet support surface, and does not call for runners of any type. The Specification describes runners in the form of inverted domes. Spec. 4:7-8; figs. 1-3. Because the language of claim 20 is broader than a particular embodiment disclosed in the Specification, we decline to import such a limitation (runners) from the Specification to the claims. *See e.g., Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003); *see also Markem-Imaje Corp. v. Zipher Ltd.*, 657 F.3d 1293, 1300-01 (Fed. Cir. 2011) (even if a device will only operate if certain elements are included, that is not grounds to

incorporate those elements into the construction of the claims).

Consequently, Appellant's argument is unpersuasive because it is not commensurate in scope with claim 20.

Appellant's arguments that Marcoux's device is incapable of free movement along a non-linear path are unpersuasive, and thus, Appellant failed to carry the burden of showing that Marcoux's device is incapable of freely moving along a non-linear path. Further, we fail to see, and Appellant fails to identify, a structural distinction between the subject matter of claim 20 and Marcoux's device. *In re Schreiber*, 128 F.3d, 1473, 1477-78 (Fed. Cir. 1997) (Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, provided the structure is capable of performing the function.).

Appellant also asserts that Campbell is non-analogous "vis-a-vis the technical field of Appellant's invention," because, "an article for opening sides of envelopes is not reasonably related, or analogous, to cutting sheets of paper or other flat material," and because it is Appellant's disclosure that defines the field of the invention. App. Br. 10 (fn1)<sup>3</sup>; Reply Br 6.

The Examiner found that paper envelopes, such as those disclosed in Campbell, are sheet material and that Campbell's device is capable of cutting other sheet material. Ans. 7 (incorporating pp. 7-10 of the Office Action dated July 11, 2001). The Examiner also found that Campbell was in the field of Appellant's endeavor because Campbell and the claimed device are similar in structure and function in that each are handheld devices used to cut paper or sheet material. *Id.*; see also *In re Bigio*, 381 F.3d 1320, 1325-27 (Fed. Cir. 2004) (The "field of endeavor" test asks if the structure

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<sup>3</sup> Incorporating argument from the Amended Appeal Brief filed February 19, 2003, pp. 21-24.

and function of the prior art is such that it would be considered by a person of ordinary skill in the art because of the similarity to the structure and function of the claimed invention as disclosed in the application.). Appellant's argument is unpersuasive because it does not point to any particular error in the Examiner's findings.

As such, we sustain the rejection of claims 20-24.

#### CONCLUSIONS

Marcoux's apparatus is freely movable in both a linear and a non-linear path as called for in claim 20.

Campbell is analogous art.

#### DECISION

We affirm the Examiner's decision to reject 20-24.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED